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2

In re Application of
Windsor et al.
Serial No. : 10/047,251
Filed : 14 January 2002
Attorney Dkt No. : TEXG:003USD1

Decision on Petition

This letter is in response to the Petition under 37 C.F.R. 1.144, filed on 12 October 2004, to request reconsideration of the restriction requirement. The delay in acting on this petition is regretted.

BACKGROUND

A review of the file history shows that the application was filed on January 14, 2002 with claims 20, 21 and 25-50 pending. In a preliminary amendment dated May 8, 2002, applicants amended claims 20 and 32-50.

A requirement for restriction was mailed to applicants on March 31, 2004, requiring the restriction of the claims to one of twenty inventions under 35 U.S.C. 121. The claims were restricted as follows:

Groups I-XIX, Claims 20-21, 26, 28-31 and 51, respectively, drawn to methods of increasing drug resistance with compound I through XIX, respectively, classified in class 514, subclasses 365, 517, 603, 476, 359, 614, 476, 615, 510, 613, 555, 622, 457, 448, 518. Claims 32-50 were each grouped in Groups I-XIX, respectively. Group XX, claims 25 and 27, drawn to a method of increasing drug resistance by a) treating with an ectophosphatase inhibitor and b) down regulating the ABC transporter, classified in class 514, subclasses 424.

A requirement to elect a single disclosed species with respect to (a) cell type for the drug resistance, (b) organism for the ABC transporter, and (c) organism for the ectophosphatase was also made.

In the paper filed on May 3, 2004, applicants elected with traverse to prosecute claims 20-21, 26, 28-31, 32 and 51, Group I. In response to the species election requirement, applicants elected without traverse (a) plant cells, (b) *Arabidopsis thaliana* AtPGP-1 and (c) *Pisum sativum* apyrase.

Applicants' traversal of the restriction requirement, on the basis that claim 20 generically links all of the pending claims and that this had not been acknowledged on the record was not found persuasive by the office and the restriction requirement was made final in a first office action on the merits, mailed June 7, 2004. In that office action, claims 25, 27 and 33-50 were

withdrawn from consideration, while claims 20, 21, 26 and 28-31 were rejected 35 USC 102(b) as anticipated by Pietkiewicz et al. Ujhazy et al. and Ujhazy et al. and claims 20, 21, 26 and 28-31 were rejected under 35 USC 102(e) as being anticipated by Thomas et al.

Applicants responded to the above first office action on the merits on October 12 2004, by amending claims 20, 26, 27 and canceling claims 21 and 28-31 and by traversing the previous rejections and by filing the instant petition in question.

DISCUSSION

Applicants' petition under 37 C.F.R. 1.144, on the basis that: 1. the restriction requirement was not proper because the claims are generically linked by claim 20, 2. the examiner has failed to state a basis for the restriction requirement and 3. the restriction requirement is not permitted under M.P.E.P. 803.

Applicants are persuasive, with respect to applicants first traversed issue, that the restriction requirement was not proper because the claims are generically linked by claim 20 as discussed below.

Claim 20. A method for decreasing drug resistance in a target plant cell comprising introducing to the cell a drug resistance-inhibiting amount of an ecto-phosphate inhibitory molecule.

Claim 20 is generic with respect to the type of molecule.

Claims 20 and 25-27 link(s) Inventions I through XIX. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claims 20 and 25-27. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Applicants additionally petition under 37 C.F.R. 1.144, on the basis that the examiner has failed to state a basis for the restriction requirement, as applicants submit that a statement of conclusions is all that has been provided and that no basis has been provided for the propriety of the restriction. Applicants support for applicants instant conclusion references that "in the restriction requirement, it is merely concluded that claim 20 is not a linking claim because elements such as the nature of the inhibitor are not specified with particularity". As discussed above, claim 20 as well as claims 25-27 dependent there from link(s) inventions I through XIX and the restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claims 20 and 25-27.

As a result of the designation of claims 20 and 25-27 as linking claims, the previous restriction requirement is thus modified as per the following:

Groups I-XIX, claims 51 and 32-50, respectively, each drawn to a method for increasing drug resistance with compounds I-XIX, respectively.

It is noted that each of the nineteen claims 32-50 each correspond to a single Group I-XIX, respectively, and claim 51 from which claims 32-50 each depend, is grouped within all Groups I-XIX, as claim 51 is drawn to the claimed method for decreasing drug resistance in a plant cell comprising the use of a compound selected from the Formulae I through XIX.

Applicants' previous election of Group I, claims 32, and 51, classified in class 514, subclass 365, is acknowledged. It is further acknowledged that claims 20 and 25-27 link(s) inventions I through XIX. The restriction requirement among the linked inventions is subject to the non-allowance of the linking claim(s), claims 20 and 25-27.

It is further noted that claim 51, which lists each of the different compounds in the alternative, will be examined to the extent that it reads on the elected invention. Claim 51 is not eligible for election of species practice because the claim does not contain a substantial structural feature that links the different compounds. Linking claims 20 and 25-27 will be examined to the point of the determination of their non-patentability. Claim 32 will be examined fully.

Applicants finally petition under 37 C.F.R. 1.144, on the basis that the restriction requirement is not permitted under M.P.E.P. 803. Applicants submit that the MPEP 803 states that "[I]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." Applicants submit that a search and examination of all the current claims would not cause a serious burden to the examiner because the limitations forming the basis for the Restriction Requirement are all found in claims dependent upon claim 20 and that once this claim is searched and found allowable, there is no additional burden in searching the remaining claims because they are by definition novel and non-obvious. Thus applicants argue all of the claims can therefore be examined together with claim 20 without any additional burden.

This argument is not persuasive because claim 20 has not been identified as allowable over the prior art. For example Pietkiewicz et al. (1998) disclose that administering the ecto-5'-nucleotidase inhibitor a,b-methylene-adenosine 5'-diphosphate reduced the drug resistance of several human and murine MDR tumor cell lines to doxorubicin.

Applicants are correct that if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions (803.02). Applicants' complete argument is acknowledged, however, found non-persuasive, because each of the groups I through XIX are drawn to a distinct methods of increasing drug resistance with distinct compounds (i.e. those distinct compounds of the formulae I through XIX). The members of the Markush group are not sufficiently few in number and are not so closely related that a search and examination of the entire application can be made without a serious burden. Searches of each of the different methods of using the compounds of the formulae I through XIX would involve the separate search of distinct structures not required for the search of other groups.

Additionally each of the compounds having the formulae I through XIX share no identifiable core structure that would help in the search of the methods of use of the distinct compounds.

Applicants' comments regarding the potential allowability of claims dependent from the linking claim, are appreciated although not helpful in supporting applicants' position regarding search burden. It is noted that in the previous first action on the merits, claim 20 (linking claim) was rejected as being anticipated under 102(b) by three different references and claim 20 was also rejected as being anticipated under 102(e) by at least a single reference. Thus the dependence of the claims on claim 20 does not relieve the necessary search burden associated with the search and examination of each of these claims. Linking claim practice requires rejoinder of non-elected inventions when the claims are in condition for allowance.

DECISION

For these reasons, the Petition under 37 C.F.R. 1.144 to petition the restriction requirement, is **GRANTED-in-PART**. As discussed above, the restriction requirement, while essentially correct, was incomplete for not indicating that the claims are generically linked by claim 20. The examiner should have identified the linking claim and made the record clear concerning linking claim practice (See MPEP 809). The petition of the restriction requirement on the basis that restriction is not permitted under M.P.E.P. 803 is not found persuasive. Absent an allowable linking claim, the restriction between Groups I-XIX stands.

Any request for consideration of this petition decision must be filed within two (2) months of the mailing date of this decision.

The application will be forwarded to the examiner for the appropriate action and consideration of applicants' response filed October 12, 2004. Should the linking claim become allowable, any claims dependent upon or containing all limitations of the linking claim would be considered for rejoinder.

Should there be any questions regarding this decision, please contact Special Program Examiner Julie Burke, by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (571) 272-1600 or by Official Fax at 703-872-9306.



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